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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/064,252 | 06/26/2002 | Chien-Liang Yeh | 112.P14209 | 8435 |

43831 7590 04/24/2007
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| EXAMINER |
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LEE, CHEUKFAN

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2625

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/24/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/064,252 | Applicant(s) YEH, CHIEN-LIANG | |
| | Examiner Cheukfan Lee | Art Unit 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-14,17,20-24 and 27 is/are rejected.
- 7) ☒ Claim(s) 15,16,18,19, and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-24, 26, and 27 are pending. Claims 1, 10 and 21 are independent.
2. The indicated allowability of claims 10-14, 17, and 20 is withdrawn in view of the newly discovered reference(s) to Short et al. (U.S. Patent No. 6,687,024). Rejections based on the newly cited reference(s) follow.

3. Claim 15 is objected to because of the following:

Claim 15 recites "at least one a portion of the plurality of elements are disposed parallel with respect to one another such that one of the plurality of resilient elements comprises a length greater than the other resilient elements". It seems that the claim limitation "such that one of the plurality of resilient elements comprises a length greater than the other resilient elements" should read – such that one of the portion of the plurality of resilient elements comprises a length greater than the other resilient elements --. Please clarify.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 10-12, 14, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Short et al. (U.S. Patent No. 6,687,027) in view of Chen et al. (U.S. Patent No. 5,652,665).

Regarding claim 10, Short et al. discloses an apparatus comprises a scanning device (Figs. 1 and 4), having a document cover (14) and a lower case (base 12), a transparent window (18) disposed on the lower case (12), and a plurality of resilient elements (spring stops 56, 57 and 58 of bezel 16 of the lower case 12, which are understood/interpreted to include resilient elements, since the spring stops 56 and 57 are disclosed to "urge the plate 18 against datum points 47 and 48, and 58 against datum point 46) disposed on the lower case (12) such that at least a portion of the plurality of resilient elements (57s) abut at least a portion of the transparent window (18) (col. 6, lines 18-30, col. 5, line 62 – col. 6, line 17).

Short et al. differs from the claimed invention in that the cover is not in form of a case or upper case.

Chen et al. discloses a transparency adapter (10) used with a flatbed scanner (20) (col. 1, line 66 – col. 2, line 18, Fig. 1). The case of scanner (20) having a transparent window corresponds to the claimed lower case. The transparency adapter comprises a shell (14, which is a case), a light source (11) and other components mounted inside the shell (14), and a transparent cover board (13). The transparency adapter (10) functions also as a document cover for covering a document placed on the scanner window (21). One of ordinary skill in the art would have realized the advantage of employing the transparency adapter of Chen et al. to enable scanning a transparent

document. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the concept of Chen et al. to replace the document cover (14) of Short et al. with a transparency adapter as taught by Chen et al. in order to allow scanning of a transparent document.

Regarding claim 11, the transparent window (18) of Short et al. is shown to be generally rectangular shaped (Figs. 1 and 4), and comprises a top surface, a bottom surface and four edges (Fig. 4). The plurality of resilient elements (56 and 57 in Fig. 4) abuts at least one of the edges (col. 6, lines 18-29).

Regarding claim 12, at least a portion of (each of) the plurality of resilient elements (56 and 57) is understood to inherently comprise flexible material (spring) (col. 6, lines 18-29).

Regarding claim 14, the resilient elements (56, 57 and 58) are arranged to form a plurality of groups of resilient elements, with elements (56 and 57) in one group and element (58) in another group (Fig. 4).

Regarding claim 17, at least a portion (56 and 57) of the resilient elements (56, 57 and 58) is disposed to form a symmetrical group of resilient elements as shown in Fig. 4.

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Regarding 20, the inherent flexible material (springs of spring stoppers 56-58) is considered shock-absorber for the transparent window (18) (Fig. 4, col. 6, lines 18-29).

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Short et al. (U.S. Patent No. 6,687,024) in view of Chen et al. (U.S. Patent No. 5,652,665) as applied to claims 10 and 12 above, and further in view of well known art.

Regarding claim 13, the apparatus of Short et al. in view of Chen et al. is discussed above for claims 10 and 12. Short et al. does not disclose that the flexible material of the resilient elements (56 and 57) (Fig. 4) comprises rubber. As understood, the resilient elements (spring stoppers 56 and 57 which urges the transparent window 18 against datum points 47 and 48) comprise springs as the flexible material (col. 6, lines 18-29). The Examiner took Official Notice of the fact that rubber is a type of inexpensive material employed to make resilient elements for protective purposes. One of ordinary skill in the art would have recognized the benefit of utilizing inexpensive rubber as compared to the material to make the springs of the spring stoppers 56 and 57 of Short et al., which generally are made of metal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well known concept to provide resilient elements made of rubber to abut or urge the transparent window (18) against the datum points of Short et al., to reduce the cost of the apparatus.

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 21-23 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Short et al. (U.S. Patent No. 6,687,024).

Regarding claim 21, Short et al. is discussed above for claim 10. Short et al. meets the claim 21 limitations. The transparent window (18) of disposed on the scanning device (Fig. 1) meets the claimed transparent window on a scanning device. The plurality of resilient elements (spring stoppers 56-58) on the case (12) (Fig. 4) meets the claimed plurality of resilient elements on the case, and the plurality of groups of resilient elements (group 56 and 57, and group 58) abutting at least a portion of the transparent window (18) meets the claimed at least a portion of the plurality of groups of resilient elements abut at least a portion of the transparent window. Thus, the disposing the transparent window (18) on the scanning device and the disposing the plurality of resilient elements (56-58) of Short et al. meet the claimed disposing a transparent window and disposing a plurality of resilient elements, respectively.

Regarding claim 22, the transparent window (18) of Short et al. is shown to be generally rectangular shaped (Figs. 1 and 4), and comprises a top surface, a bottom surface and four edges (Fig. 4). The plurality of resilient elements (56 and 57 in Fig. 4) abuts at least one of the edges (col. 6, lines 18-29).

Regarding claim 23, at least a portion of (each of) the plurality of resilient elements (56 and 57) is understood to inherently comprise flexible material (spring) (col. 6, lines 18-29).

Regarding 27, the inherent flexible material (springs of spring stoppers 56-58) is considered shock-absorber for the transparent window (18) (Fig. 4, col. 6, lines 18-29).

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Short et al. (U.S. Patent No. 6,687,024) in view of well known art.

Regarding claim 24, the method of Short et al. is discussed above for claim 21 and 23. Short et al. does not disclose that the flexible material of the resilient elements (56 and 57) (Fig. 4) comprises rubber. As understood, the resilient elements (spring stoppers 56 and 57 which urges the transparent window 18 against datum points 47 and 48) comprise springs as the flexible material (col. 6, lines 18-29). The Examiner took Official Notice of the fact that rubber is a type of inexpensive material employed to make resilient elements for protective purposes. One of ordinary skill in the art would

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have recognized the benefit of utilizing inexpensive rubber as compared to the material to make the springs of the spring stoppers 56 and 57 of Short et al., which generally are made of metal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well known concept to provide resilient elements made of rubber to abut or urge the transparent window (18) against the datum points of Short et al., to reduce the cost of the apparatus.

10. Claim 15 would be allowable if rewritten to overcome the objection(s) set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 16, 18, 19, 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 1-9 are allowed.

13. The following is an examiner's statement of reasons for allowance:

Claim 15 would be allowable because the closest prior art Short et al. (U.S. Patent No. 6,687,024) does not disclose that the plurality of resilient elements (56 and 57), or a portion of the plurality of elements (56 and 57) are disposed such that one of the plurality of resilient elements, or one of the portion of the plurality of resilient

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elements, comprises a length greater than the other resilient elements (in the portion), although the resilient elements (56 and 57) are disposed parallel with respect to each other (Fig. 4). The resilient elements (56, 57) of Short et al. are shown to have equal length (Fig. 4).

Method claim 26 corresponding to apparatus claim 15 but does not have the problem for which claim 15 is objected above in section 3. Claim 26 would be allowable for the reason given for claim 15.

Claim 16 would be allowable because the closest prior art Short et al. (U.S. Patent No. 6,687,024) does not disclose that the respective lengths of the resilient elements (56 and 57) decreases from the center of the group to the outermost portions of the group (56 and 57).

Claim 18 would be allowable because the closest prior art Short et al. (U.S. Patent No. 6,687,024) does not disclose disposing the resilient elements (56-58) to form a stepped distribution of resilient elements (see Fig. 4 of Short et al.).

Claim 19 would be allowable because the resilient elements (56-58) of Short et al. (U.S. Patent No. 6,687,024) are not generally bar-shaped (see Fig. 4).

Claim 1 is allowable over the prior art of record because the closest prior art Short et al. (U.S. Patent No. 6,687,024) does not disclose a slot of the lower case of the

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scanning apparatus, i.e., the slot within which a plurality of resilient elements are mounted, or adapted to be mounted. This feature in combination with other limitations of claim 1 is not taught by Short et al. The resilient elements (56-58) of Short et al. are shown to be attached to the bezel (16) of the lower case (base 12).

Claims 2-9 depend on claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheukfan Lee
April 10, 2007